



UNITED STATES PATENT AND TRADEMARK OFFICE

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TOPE-MCKAY & ASSOCIATES
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MALIBU, CA 90265

MAILED
MAR 21 2011
OFFICE OF PETITIONS

In re Patent of Neil Stratton :
Patent No. 6,793,224 :
Issue Date: September 21, 2004 :
Application No. 09/801,536 :
Filing Date: March 8, 2001 :
Attorney Docket No. CS1001 :

Letter

Request for Information

This letter is being issued in response to the petition under 37 CFR 1.378(b) filed November 1, 2010.

Petitioner should submit the information requested in this letter within **TWO MONTHS** of the mailing date of this letter. Extensions of time may not be obtained. No additional fee is due for a response to the instant request for information. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

Facts

Application No. 09/801,536 was filed March 8, 2001.

During late 2002, the firm of Tope-McKay & Associates began assisting the inventor, on a piece-meal basis," to respond to communications from the USPTO.

In order to reduce docketing costs and maintain control of prosecution, the inventor had all communications sent to the following address:

Eyreick Williamson, President
Carver Skateboards, Inc.
245 Turnbull Canyon Road
City of Industry CA 91745

The Office mailed a Notice of Allowance on February 20, 2003.

The inventor prepared and filed drawings and the issue fee transmittal form on April 15, 2003.

Office records failed to indicate the Office received the issue fee. As a result, the Office mailed a Notice of Abandonment on June 27, 2003.

A petition under 37 CFR 1.137(b) was filed by the law firm on June 8, 2004. The petition asserted a check for the issue fee was filed with the April 15, 2003 papers. A decision granting the petition under 37 CFR 1.137(b) was mailed June 16, 2004.

The application issued as patent on September 21, 2004.

As a courtesy, the law firm entered the maintenance fee due date into its docketing system.

The 3.5 year maintenance fee could have been paid from September 21, 2007, to March 21, 2008, or with a surcharge from March 22, 2008, to September 22, 2008.

At the time the maintenance fee first became due, "Carver Skateboards, Inc. was managed by Eyreick Williamson, who was responsible for ensuring payment of the Maintenance Fee window."

On or about February 29, 2008, the law firm sent a maintenance fee reminder via e-mail to neil.stratton@comcast.net, the e-mail address for the inventor in the firm's docketing system. However, the inventor never received the e-mail because his correct e-mail address was neilstratton@comcast.net.

The petition states,

Petitioner was displeased with the management as provided by Eyreick Williamson and, in approximately August of 2008, the Petitioner removed Eyreick Williamson and took over Carver Skateboards, Inc.; however, Petitioner believed that the Maintenance Fee had been taken care of by previous management.

On October 19, 2010, the law firm discovered the expiration of the patent while preparing a letter to a competitor alleging infringement of the patent.

The instant petition was filed November 1, 2010.

Request

The petition references several exhibits. However, the Office is unable to locate a copy of any of the exhibits in the file. The Office requests Petitioner supply a copy of the exhibits.

Recommendation

The Office strongly recommends, but is not requiring, Petitioner supply a statement from both Williamson and Stratton.

The Office also strongly recommends, but is not requiring, Petitioner supply information addressing the following questions:

1. Did Stratton ever assign his rights in the patent to Carver Skateboards? If yes, when?
2. Did Stratton inform Williamson that Stratton was relying on Williamson to ensure maintenance fees would be timely paid for the patent?
3. Did Williamson ever agree to take steps to ensure maintenance fees would be timely paid for the patent?
4. Did Stratton take any steps to ensure maintenance fees would be timely paid for the patent? If yes, what steps did he take?
5. Did Williamson take any steps to ensure maintenance fees would be timely paid for the patent? If yes, what steps did he take?
6. What is the specific date on which Stratton replaced Williamson?
7. Why did Stratton, when he replaced Williamson, assume the 3.5 year fee had already been paid even though the last day the fee could have been timely paid was September 22, 2008?
8. What steps, if any, did Stratton take to ensure the 7.5 year maintenance fee would be timely paid?

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.¹ Document Code "PET.OP" should be used if the request is filed electronically.

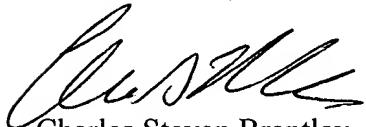
By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

¹ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
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